

REMARKS

The drawings stand objected to for inadequacy of the top margin. Applicant submits herewith corrected drawings which are believed to fully comply with the Office's drawings standards. No new matter has been added. Acceptance of the corrected drawings and reconsideration and withdrawal of the objection are therefore respectfully requested.

Claims 1 and 2 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. patent No. 6,038,333 issued March 14, 2000 to Wang ("Wang") in view of U.S. patent No. 5,180,901 issued January 19, 1993 to Hiramatsu ("Hiramatsu") and U.S. patent No. 6,137,685 issued October 24, 2000 to Morinaga ("Morinaga").¹ For the following reasons, Applicant respectfully traverses the foregoing rejections.

The test of obviousness *vel non* is statutory. *In re Ochiai*, 71 F.3d 1565, 1569 (Fed. Cir. 1995). In order to establish obviousness, it must be shown that the claimed subject matter, taken "as a whole," would have been "obvious at the time the invention was made to a person having ordinary skill in the art to which [the] subject matter pertains." 35 U.S.C. § 103(a). A proper showing, however, must rest upon several factual inquiries: (1) the scope and content of the prior art; (2) the differences between the prior art and the invention as claimed; (3) the level of ordinary skill in the art; and (4) the objective evidence of non-obviousness. *See Graham v. John Deere Co.*, 383 U.S. 1 (1966).

Looking initially to the cited references as exemplary of the prior art, it is first noted that, as apparently agreed by the Office, Wang is directed toward a handheld person identifier having embedded therein various components including a face image database and a camera. Additionally, Wang discloses the provision of a face analysis system, which may be coupled to the camera and the image database for purposes of identifying a person. Morinaga, which does not appear to pertain in any manner to face recognition, discloses at least one exemplary embodiment of what may be termed a "smart card." Finally,

¹ Although Applicant now traverses the present rejection of the claims on the merits as a matter of expediency, Applicant in no manner admits the disclosure of Morinaga, citable only under the provisions of 35 U.S.C. § 102(e), to be "prior art" to the invention of the present application.

Hiramatsu, on the other hand, is directed toward a pressure sensing device, well-known to involve much simpler technologies than involved in the invention of the present application.

Turning now to the second prong of *Graham* and examining the differences between the prior art, taken as a whole, and the recitations of claims 1 and 2, also read as a whole, it is immediately apparent that in none of the cited references is there disclosed the placement on a smart card of a camera or is such a placement anywhere suggested. To the contrary, the primary reference discloses placement of such a camera within a handheld computing device, a device far more bulky than what is contemplated by Applicant's invention as positively claimed and wholly inappropriate for implementation of Applicant's invention. To be sure, modification of the Wang device to meet the limitations of Applicant's invention would completely destroy the intended result taught by Wang. This, of course, is the very antithesis of obviousness.

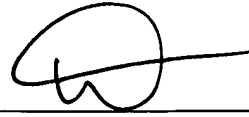
The only remaining question in the obviousness determination is then whether one of ordinary skill in the art would have been motivated to bridge the gap between the teachings of the prior art and the invention as positively claimed by Applicant. The metric by which this question must be answered is whether there existed in the prior art itself at the time of Applicant's invention some suggestion for the combination such that the skilled artisan would not only have been motivated to complete the invention but also would have been left with a reasonable expectation of success. *See* M.P.E.P. § 2141, last paragraph. Clearly no such suggestion is to be found. To conclude that one of ordinary skill would be motivated by references teaching merely the existence of smart cards and the incorporation of very simple functionality thereon, Morinaga and Hiramatsu, respectfully, to abandon the teachings of Wang in favor of a result only suggested in Applicant's own disclosure is without credibility. A *prima facie* showing of obviousness thus having not been set forth, Applicant respectfully requests reconsideration and withdrawal of the rejections and allowance of the claims.

In light of all the foregoing, Applicant respectfully requests reconsideration and allowance of the claims and passage to issue of this present application.

Respectfully submitted,

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A handwritten signature in black ink, appearing to be 'WJ Colton', written over a horizontal line.

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